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REMARKS

In the Final Office Action, the Examiner rejected claims 1-51. By this Response, Applicant amended claims 1, 3, 20, 21, 27, 33-35, 37, 38, and 43-50 and canceled claim 51 to clarify certain aspects of the present claims and to expedite allowance of the present application. No new matter has been added by the foregoing amendments. In view of the foregoing amendments and the following remarks, the Applicant respectfully requests reconsideration and allowance of the pending claims 1-51.

Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 1-51 under 35 U.S.C. § 103(a) as obvious over Goodrich et al. (U.S. Patent No. 5,375,076) in view of Jacklin (U.S. Patent No. 6,396,472). Applicant respectfully traverses this rejection.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). If the Examiner combines the teachings of the prior art to produce the claimed invention, a *prima facie* case of obviousness cannot be established absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

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As amended, independent claim 1 recites, *inter alia*, “a wall mount structure configured to mount the housing on a substantially vertical surface.” Amended independent claim 21 recites, *inter alia*, “an upright surface mount configured to mount the housing to a substantially upright surface.” Amended independent claim 37 also recites, *inter alia*, “a surface mount configured to mount the computer enclosure to a wall.” Finally, amended independent claim 46 recites, *inter alia*, “coupling a vertical surface mount to the panel enclosure.”

In the Final Office Action, the Examiner acknowledged that Goodrich et al. “did not disclose a mount structure configured to mount the housing on a substantially vertical surface.” Paper No. 6, Page 3. In view of the deficiencies of a Goodrich et al., the Examiner turned to Jacklin for a teaching of a wall hanging orifice 31 for hanging an electronic picture frame 1. Abstract; Col. 7, lines 38-42. However the Examiner mischaracterized the electronic picture frame 1 of Jacklin as a computer display. Paper No. 6, Page 3.

No Suggestion or Motivation to Combine

The Applicant emphasizes the lack of any motivation or suggestion to combine the references. In the Office Action, the Examiner stated:

It would have been obvious to a person of ordinary skill in the computer art at the time the invention was made to supplement said display of Goodrich with the mount structure as taught by Jacklin in order to facilitate mounting of the display of Goodrich on the vertical surface.

Paper No. 6, Page 3. As quoted above, the Examiner’s alleged reason to combine the references provides nothing more than the function of a mount structure. The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re*

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Lee, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). In the present rejection, the Examiner combined the Goodrich et al. and Jacklin references based on the *conclusory and subjective statement* that the mount structure of Jacklin *could* mount the display of Goodrich et al. on the vertical surface, yet the Examiner provided no reasoning as to why such a combination would or could be made. Accordingly, Applicant challenges the Examiner to produce objective evidence supporting the Examiner's alleged reason to combine the cited references.

Even if objective evidence is identified to support the Examiner's alleged reason to combine the references, the Applicant submits that one of ordinary skill in the art would not be motivated to combine the Goodrich et al. and Jacklin references. The Examiner's alleged reason to combine the references provides nothing more than the function of a wall mount. There is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention. *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 U.S.P.Q.2d. 1415, 1420-21 (Fed. Cir. 1999). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Moreover, a statement that the proposed modification would have been "well within the ordinary skill of the art" based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levingood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d. 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d. 1161 (Fed. Cir. 1999). Again, the Applicant challenges the Examiner to provide *objective evidence* of the requisite suggestion or motivation to combine or modify the references, rather than a mere statement of a wall mount's function.

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Jacklin Teaches Away from Goodrich et al.

The Examiner clearly *speculated* about the possibility of combining the reference without providing any objective evidence. In the process, the Examiner ignored the disclosure of Jacklin, which clearly teaches away from a combination with the Goodrich et al. reference. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. The Applicant further emphasizes that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959); see M.P.E.P. § 2143.01.

Turning to the cited references, Goodrich et al. teaches a combined notepad and notebook computer P1, which comprises a keyboard 24, a display 26 having a digitizer for use with a stylus, a floppy disk drive 42, a hard disk drive 44, a modem 46, batteries 50, a circuit board 52, and so forth. Abstract; Col. 3, lines 26-45; Col. 4, line 54 – Col. 5, line 17. Accordingly, the computer P-1 of Goodrich et al. is configured for *user interaction and computing*, rather than mere viewing of pictures.

In contrast, Jacklin teaches the electronic picture frame 1 "for displaying, arraying, fixing, and generally enjoying same in the *traditional modes* by which photographic images have been known and cherished over the time." Abstract; Col. 3, lines 52-58 (emphasis added). As one of the objects of the invention, Jacklin also discloses that the "electronic frame functions as a *free standing unit* and may be used *without the need for complex or high-technology interfacing assistance*." Abstract; Col. 3, lines 8-19 and 62-64; Col. 5, lines 36-45. More importantly, Jacklin explicitly teaches

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away from "the context of personal computers, the like complex computer-based technologies, or cumbersome coaxial cable and television equipment." Col. 3, lines 8-20.

In view of the foregoing passages, one of ordinary skill in the art would be discouraged from combining the user interactive computer P1 of Goodrich et al. with the electronic picture frame 1 of Jacklin. Moreover, if combined, the references would change the principle of operation of each respective device. Accordingly, the Applicant respectfully requests the Examiner to withdraw the proposed combination of Goodrich et al. and Jacklin.

Jacklin is Non-Analogous Art

For the teachings of a reference to be prior art under 35 U.S.C. § 103, there must be some basis for concluding that the reference would have been considered by one skilled in the particular art working on the particular problem with which the invention pertains. *In re Horne*, 203 U.S.P.Q. 969, 971 (C.C.P.A. 1979). Non-analogous art cannot properly be pertinent prior art under 35 U.S.C. § 103. *In re Pagliaro*, 210 U.S.P.Q. 888, 892 (C.C.P.A. 1981). The determination of whether a reference is from a non-analogous art is set forth in a two-step test given in *Union Carbide Corp. v. American Can Co.*, 724 F.2d 1567, 220 U.S.P.Q. 584 (Fed. Cir. 1984). In *Union Carbide*, the court found that the first determination was whether "the reference is within the field of the inventor's endeavor." If it is not, one must proceed to the second step "to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved." In regard to the second step, *Bott v. Fourstar Corp.*, 218 U.S.P.Q. 358 (E.D. Mich. 1983) determined that "analogous art is that field of art which a person of ordinary skill in the art would have been apt to refer in attempting to solve the problem solved by a proposed invention." "To be relevant the area of art should be where one of ordinary skill in the art would be aware that similar problems exist." *Id.*

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Based on the foregoing two-part non-analogous art test, the Jacklin reference does not qualify as analogous art. In regard to the first step of the *Bott* test, an electronic picture frame is in a completely different field of art from the Applicant's field of endeavor, i.e., computer systems and devices. The field of picture frames is generally limited to *displaying* non-user-interactive images, which has no rational relationship to the field of computer systems. The mere inclusion of circuitry, memory, processors, display screens, and other electronic components does not render a picture frame within the field of computer systems, because such components are merely electronic equivalents to the physical frame and glass of a conventional picture frame. Regardless of form, a frame functions as a *viewing receptacle* for pictures. In contrast, the field of computers is directed toward interactive computing, user interactive hardware and software, and so forth. Accordingly, a skilled artisan in the field of computers would have little or no knowledge of picture frames and vice versa. Therefore, the Jacklin reference is not in the field of Applicant's endeavor.

In regard to the second step of the *Bott* test, the problems associated with picture frames are completely different from the problems associated with computers. Computers often require complex computing circuitry, processors, and other components to execute code, such as an operating system and applications software. Moreover, given all of the components and peripherals of computers, the mounting problems are much more complex than electronic picture frames and space considerations are a major concern. Applicant addressed this space consumption problem in a unique and non-obvious manner by providing an upright or vertical mounting mechanism, while others have merely used horizontal mounts. See Goodrich et al., Figures 4, 9, and 17. In contrast, the problems associated with electronic picture frames arise primarily from the need for easy access and display of a large number of digitally stored pictures. See Jacklin, col. 1, lines 48-56. The problems associated with electronic picture frames do

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not concern the operation or problems associated with computers, nor do they have anything to do with mount structures for computers. Thus, there is no evidence whatsoever that similar problems exist in these disparate fields of art, much less any evidence to suggest that one of ordinary skill in the art of computers or computer mounts would consult the art of electronic picture frames or photography for any reason. Accordingly, the Jacklin reference is believed to be non-analogous art. Applicant respectfully requests removal of the Jacklin reference from consideration.

In view of the foregoing remarks, independent claims 1, 21, 37, and 46 are believed to be patentable over the Goodrich et al. and Jacklin references. Claims 2-20, 22-36, 38-45, and 47-50 are also believed to be patentable over the cited references by way of their dependencies on independent claims 1, 21, 37, and 46 and by way of further distinguishing features recited in each respective claim. Accordingly, Applicant respectfully requests withdrawal of the outstanding rejections under 35 U.S.C. § 103(a).

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Conclusion

The Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

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